

### **REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-20 are presently active in this case. The present Amendment amends Claims 1 and 11 without introducing any new matter.

Claims 1-20 were rejected under 35 U.S.C. §102(e) as anticipated by Foladare et al. (U.S. Patent No. 5,905,777, herein "Foladare").

To correct a minor formality and to clarify Applicants' invention, Claim 1 is amended to recite "including" instead of "indicating" and Claim 11 is amended to recite "identifying a service of the service request message by the information processor." This feature was already included in original Claim 1 and is therefore not believed to raise any new issues.

In response to the rejection of Claims 1-20 under 35 U.S.C. §102(e) over Foladare, Applicants respectfully request reconsideration of this rejection and traverse the rejection, as discussed next.

Briefly recapitulating, independent Claim 1 is directed to a device in a communication network having multiple sub-networks, where each of the sub-networks includes services that may be different from that of other sub-networks. The device includes, *inter alia*, an information processor configured to receive a service request message from a first sub-network, wherein the service-request message ***includes information on a service to be executed***, and the ***information processor is further configured to identify the service***. Amended independent Claim 11 recites similar features in the context of a method for identifying a sub-network.

As explained in Applicants' Specification from page 4, line 30 to page 5, line 7 with corresponding Figures 2-4, Applicants' invention improves upon background communication

networks having multiple sub-networks because the claimed device provides seamless and efficient communication of services between different constituent parts of a network and can prevent inefficient accessibility of services from users of a different network.

Turning now to the applied reference, Foladare discloses a communication system including an E-mail server and an E-mail network, in which useful E-Mail messages can be identified, separated from junk mail, and forwarded as directed by the recipient.<sup>1</sup> However, Foladare fails to teach the information processor that is configured to receive a service request message from a first sub-network, said service-request message including a service to be executed, wherein *the information processor is configured to identify the service*. Foladare teaches that “E-mail messages are transmitted over an E-Mail network routed to an E-Mail server servicing the recipient, where useful E-Mail messages can be identified, separated from the junk mail, and forwarded as directed by the recipient.”<sup>2</sup> Accordingly, the E-Mail message of Foladare *does not* include information on a service to be executed. This would require that Foladare’s E-Mails would inform the E-Mail server whether the E-Mail is junk mail or not, which is certainly not the case. On the contrary, Foladare explicitly teaches that the E-Mail server receives an E-Mail message and then accesses the recipient’s record from the database. Further, Foladare’s step 406 determines if the sender ID 233 in the received message 239 matches any of the senders in the sender list 252 of the recipient’s record.<sup>3</sup> An E-Mail server managing incoming E-Mails, as taught by Foladare, *is not* a service-request message indicating a service to be executed.

The outstanding Office Action argues that the above-noted claimed feature is disclosed in Foladare’s column 2, lines 24-32.<sup>4</sup> Applicants respectfully disagree. Foladare describes that a server transmits an alert signal, in form of a summary of a message, to a

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<sup>1</sup> See Foladare in the Abstract.

<sup>2</sup> See Foladare at column 1, lines 43-46.

<sup>3</sup> See Foladare from column 4, line 65 to column 5, line 10.

<sup>4</sup> See the outstanding Office Action at page 6, lines 6-9.

pager attached to a recipients computer, and further states that “[t]he recipient can view the sender’s name and the title of the message ... and can send a selection signal to the server to forward the message to one of several destinations.”<sup>5</sup> In other words, Foladare’s recipient who received a summary of a message must view the sender’s name, the title of the message and the contents of the summary of the message, and can subsequently decide if the message has to be forwarded to other destinations, by sending a selection signal. A summary of a message sent to a recipient, thereby forwarding a selection signal to an E-mail server, as taught by Foladare, *is not* a service-request message including a service to be executed, and a recipient reading a message sender’s name, title and summary, as taught by Foldare, *is not* an information processor configured to identify the service, as claimed. Even if we assume that the telecommunication provided for a recipient is a service,<sup>6</sup> there is no information processor in Foladare that would identify the service. Since the recipient evaluates the information the message manually, and also sends a selection signal to the E-mail server manually, Foladare’s teachings do not provide an efficient accessibility of services from users of a different network.

Further, Applicants also respectfully submit that Foladare fails to teach or suggest all the features of Applicants’ dependent claims, as next discussed.

Regarding dependent Claim 3, the outstanding Office Action teaches that another information processor is connected to the information processor and this information processor configured to retrieve information form another database is an inherent feature.<sup>7</sup> First, Applicants respectfully submit that this position is insufficient to show that Foladare’s E-mail server 60 inherently teaches the claimed another information processor because it fails to show “that the alleged inherent characteristic *necessarily* flows from the teachings of the

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<sup>5</sup> See Foladare at column 2, lines 26-30.

<sup>6</sup> See the outstanding Office Action at page 6, line 8.

<sup>7</sup> See the outstanding Office Action at page 3, lines 1-6.

applied references.”<sup>8</sup> Second, Claim 3 recites that another information processor is configured to retrieve information from another database *to identify sub-networks that perform the requested service*. Foladare merely recites that a recipient can send a selection signal to the E-mail server to forward the message to one of several destinations as discussed above.<sup>9</sup> Foladare is silent on an information processor configured to retrieve information from another database to identify sub-networks that perform the requested service.

Regarding dependent Claim 7, the outstanding Office Action suggests that Foladare’s Figure 1 with items 42 and 64 describes the features of dependent Claim 7.<sup>10</sup> Again Applicants respectfully disagree. The E-Mail server of Foladare does not establish a connection with another sub-network that is different from a sub-network *from which the service request message is initiated*.

Therefore, the applied reference fails to teach or suggest every feature recited in Applicants’ claims, so that Claims 1-20 are patentably distinct over Foladare. Accordingly, Applicants respectfully traverse, and request reconsideration of, the rejection based on Foladare.<sup>11</sup>

The present Amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present Amendment is believed to overcome outstanding rejections under 35 U.S.C. §102(e), the present Amendment places the

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<sup>8</sup>See MPEP 2112 (emphasis in original) (citation omitted). See also same section stating that “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,” (emphasis in original). See also *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) (“[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill,’” citing *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991); and “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient,” *Id.* at 1269 (citation omitted)).

<sup>9</sup> See Foladare for example at column 2, lines 24-37.

<sup>10</sup> See the outstanding Office Action at page 3, line 17-20.

<sup>11</sup> See MPEP 2131: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” (Citations omitted) (emphasis added). See also MPEP 2143.03: “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

application in better form for consideration on appeal. In addition, the present Amendment is not believed to raise new issues because the changes to Claim 11 merely recite limitations previously introduced in Claim 1, and the change to Claim 1 is of a minor nature. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present Amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-20 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

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